

REMARKS

Claims 1-22 are pending. Claims 1, 4, 15, 16, and 21 have been amended.

Support for the claim amendments can be found throughout the application, including the originally-filed claims. In particular, see page 9 of the application, where the definition of aryl includes polycyclic ring systems. Importantly, no new matter has been added to the claims.

The amendments to the claims should not be construed to be an acquiescence to any of the rejections. Rather, the amendments to the claims are being made solely to expedite the prosecution of the above-identified application. The Applicant reserves the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120.

Rejection of Claims Under 35 U.S.C. § 102(b)

Claims 1-4 and 9-22 stand rejected under 35 U.S.C. § 102(b) based on the Examiner's contention that they are anticipated by Hunter (WO 99/18053). The Applicants respectfully traverse this rejection.

Amended claim 1, from which claims 2-4, 9-14, and 16-20 depend, is drawn to a polymer precursor, wherein R in formula 1 is defined as a polycyclic aryl or heteroaryl. Hunter discloses polymer precursors where the counterpart of R is a benzene ring. To anticipate a claim, a single source must contain all of the elements of the claim. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. duPont DeNemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Because Hunter only discloses benzene and not a polycyclic aryl or heteroaryl ring in its polymer precursors, the Applicants respectfully submit that Hunter does not anticipate pending claims 1-4, 9-14, and 16-20.

Amended claim 15 is drawn to three specific polymer precursors, comprising 2,3-dihydrobenzofuran (a polycyclic aryl) as R in formula 1. As previously stated, Hunter discloses polymer precursors with benzene in the R position; and, therefore, Hunter does not anticipate these three polymer precursors.

Claim 21, from which claim 22 depends, is drawn to a method of synthesizing radiolabeled benzamides on a solid support. The Examiner contends that the method of claim 21 is disclosed in Hunter, because polymer precursors comprising a benzamide moiety are disclosed (i.e., the genus on page 4 of Hunter when R₂ is a carbonyl group). The Applicants respectfully traverse this contention. The only method disclosed in Hunter is a method of forming radiolabeled compounds comprising reacting a radiohalogen with a polymer of type 2 or 3 (see pages 15 and 17 in Hunter, respectively). The Applicants respectfully submit that the steps of method claim 21 (i.e., selecting a solid support comprising a benzoic acid moiety; reacting said benzoic acid moiety with an amine to form a bound benzamide; and reacting said bound benzamide with a radiolabeled compound or isotope and an oxidant) cannot be found in Hunter. The Applicants respectfully assert that the Examiner is incorrectly attributing to Hunter a method that is not disclosed therein merely because the product of the claimed method is arguably a member of the genus disclosed in Hunter. This position is not supported by the relevant precedent. *See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986) (stating that in order to anticipate a claim, a single source must contain all of the elements of the claim).

Accordingly, the Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) of claims 1-4 and 9-22.

Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) based on the Examiner's contention that they are obvious over Hunter (WO 99/18053) in view of Reed (U.S. Patent No. 5,746,997) and Wilbur (U.S. Patent No. 5,609,848). The Applicants respectfully traverse this rejection.

The Examiner cites Reed and Wilbur to cure what the Examiner contends is lacking in Hunter, namely radiolabeled compounds which include peptides, nucleotides and other biomolecules. However, the Applicants respectfully submit that Reed and Wilbur when combined with Hunter do not disclose every element of the claimed invention. Claims 1-20 as amended are drawn to polymeric precursors, kits comprising the polymeric precursors, and methods of preparing the polymeric precursors, wherein the polymeric precursors comprise a

polycyclic aryl or heteroaryl ring. The references, either alone or in combination, do not disclose this type of polymeric precursor.

Claims 21-22 are drawn to a method of synthesizing radiolabeled benzamides on a solid support comprising selecting a solid support comprising a benzoic acid moiety; reacting said benzoic acid moiety with an amine to form a bound benzamide; and reacting said bound benzamide with a radiolabeled compound or isotope and an oxidant. As stated previously, these steps are not disclosed in Hunter. Reed and Wilbur do not supply these missing elements. Therefore, Hunter in view of Reed and Wilbur does not supply every limitation of claims 21-22 as required for a prima facie showing of obviousness under 35 U.S.C. § 103(a).

Accordingly, the Applicants respectfully request the withdrawal of the 35 U.S.C. 103(a) rejection of claims 1-22.

**Claim Rejections Based on the Judicially-Created
Doctrine of Obviousness-Type Double Patenting**

Claims 16 and 17 stand rejected under the judicially-created doctrine of obviousness-type double patenting, based on the Examiner's contention that they are not patentably distinct from claims 1-9 of U.S. Patent No. 6,461,585 ("the '585 patent"). The Applicants respectfully request that the Examiner hold in abeyance all obviousness-type double patenting rejections based on the '585 patent until allowable subject matter is indicated, at which point the Applicants will file a terminal disclaimer if necessary.

Fees

The Applicants believe they have provided for any required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any additional required fee to our Deposit Account, **06-1448**.

Conclusion

In view of the above amendments and remarks, the Applicants believe that the pending claims are in condition for allowance. If a telephone conversation with Applicant's Attorney or Agent would expedite prosecution of the application, the Examiner is urged to contact the undersigned.

Respectfully submitted,
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